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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/529,206	06/13/2000	RONG FU WANG	2026-4269US1	1577

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EXAMINER

YU, MISOOK

ART UNIT

PAPER NUMBER

1642

DATE MAILED: 09/12/2003

28

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/529,206

Applicant(s)

WANG ET AL.

Examiner

MISOOK YU, Ph.D.

Art Unit

1642

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 May 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 08 September 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 3,5-8,10-16,26,28,29 and 67-86.


Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: Interview Summary Paper Nos. 26 and 27.

Misook Yu, 9-9-2003

Continuation of 5. does NOT place the application in condition for allowance because For 102 (a) rejection, applicant argues MPEP 211.03 says that the instantly recited transition phrase "consisting essentially of" is known to not have the same meaning as "comprising", therefore the instant claimed invention reciting "consisting essentially of" does not read on the prior art which teaches the full-length protein. Applicant further argues that the instant claims recites "cancer peptides" and the specification at page 9 lines 2-3 defines "cancer peptides" as epitope or fragments and the specification at Table 7 at page 50 discloses numerous cancer peptides, therefore the full-length SEQ ID NO:4 does not read on the instantly claimed invention. The argument has been fully considered but found unpersuasive because applicant have not defined the scope of the phrase consisting essentially of for purpose of its patent by making clear in the specification what it regarded as constituting a material change in the basic and novel characteristics of the invention. Contrary to applicant's argument that instant invention excludes the full-length protein of the prior art by reciting "cancer peptides" in the preamble of the instant claims, the specification at page 9 lines 10-21 says that cancer peptide includes the 180 amino acids full-length protein taught by the prior art of record. Applicant's attention is directed that applicant elected the 180 amino acids full-length protein, i.e. SEQ ID NO:4 as species. MPEP 211.03 clearly states that if applicant contends that materials in the prior art are excluded by the recitation of "consisting essentially of", applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. Further, applicant's argument that numerous cancer peptides are disclosed at Table 7 is not commensurate in the scope of instant claims because the claims are not limited to the specific peptides sequences disclosed at Table 7.

Written description (new matter) rejection is also being maintained because it appears that "consisting essentially of", the added limitation after the claims had been rejected by prior art is to exclude the full-length protein of the prior art from the instantly invention. However, the specification as originally filed does not convey the limitation excludes the full-length protein. See the Office's response for maintaining 102 (a) rejection above. The specification as originally filed does not reasonably convey "consisting essentially of" means only anything smaller than SEQ ID NO:4. The specification as originally filed does not define the scope of the phrase "consisting essentially of" as applicant argues in 102 (a) rejection above.


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